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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,745	02/02/2001	Christopher S. Moore	10519/16	9392

7590   07/19/2006

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EXAMINER
HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/775,745	MOORE ET AL.
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *05 May 2006*.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-51 and 72-87* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-15,17-20,22,23,25-27,30-32,34-51 and 72-87* is/are rejected.

7) ☒ Claim(s) *16,21,24,28,29 and 33* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *17 May 2001* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/5/06*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-51 and 72-87 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 1, 2, 4-6, 8, 10, 12, and 18 are rejected under 35 U.S.C. 102(e) as being

anticipated by U.S. Patent No. 6,223,190 to Aihara et al.

As per claims 1, 2, and 4, a flash disk is used as a removable medium to transfer generated HTML program code from a device to a computer (see column 5, lines 55-57 and column 9, lines 27-39).

As per claims 5 and 6, the HTML program generates references to accompanying images which are retrieved by using the HTML program (see column 7, lines 22-25).

As per claim 8, HTML is a hardware-independent language.

As per claim 10, the HTML program and the accompanying images are stored in different files, thus constituting partitions.

As per claim 12, Aihara discloses an image viewer.

As per claim 18, a flash disk is composed of semiconductor memory cells.

3.   Claims 20, 22, 23, 25, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,523,117 to Oki et al.

As per claims 20 and 23, Oki discloses the use of a removable medium such as a memory stick (though it is described throughout the specification in terms of a CD-ROM), which is a solid-state (see column 1, line 40). The information on the medium is retrieved and decrypted using a key retrieved using, in part, the "CD number," which is the identifier associated with the device (see column 6, lines 22-54), which must necessarily have been stored on the medium. The retrieved material may be software (i.e. program code) (see column 1, lines 14-20).

Regarding claim 22 and 25, after a transaction is begun, the instructions for providing the code and identifier inherently execute automatically.

Regarding claim 35, a memory stick comprises semiconductor cells.

4.   Claims 76, 77, 80-82, and 85-87 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,478,222 to Sarfati.

As per claims 76 and 81, Sarfati discloses an MPEG player in a digital decoder wherein MPEG (audio/video) files and other applications are stored within a smartcard and downloaded to the decoders, and used together to display a transmission (see column 7, lines 10-31).

As per claims 77 and 82, the use of Java is disclosed (see column 6, lines 26-33).

As per claims 80 and 85, ROM (read-only memory) may be used (see column 4, line 2).

Regarding claims 86 and 87, MPEG can be used for still pictures or sequences of images.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

5.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,223,190 to Aihara et al. as applied to claim 8 above, and further in view of

U.S. Patent No. 6,481,632 to Wentker et al.

Aihara only discloses the use of HTML with the smartcard.

Wentker discloses the use of Java, and suggests that this is a suitable Smartcard

operating system (see column 6, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the

invention was made to further modify the invention of Aihara by using Java applications,

as disclosed by Wentker, as this is a suitable Smartcard operating system.

6.   Claims 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claims 10 and 17 above,

and further in view of U.S. Patent No. 6,766,417 to Tanaka et al.

Aihara does not disclose the layout of the memory with respect to persistent data

storage.

Tanaka the writing of application data stored in a buffer being written to a flash

ROM that is organized by pages, which do not change during normal operation; the

area is therefore fixed (see column 5, lines 19-23 and column 6, lines 15-18) and only

available on the solid-state memory device, and notes that when a read write control

program for the information processing unit is developed for a flash ROM (write-once

memory cells) of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program (see column 1, lines 40-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by writing application data to pages of a flash ROM, as disclosed by Tanaka, because when a read write control program for the information processing unit is developed for a flash ROM of a specific capacity, a flash ROM of some other capacity becomes unable to be utilized by the program.

7.   Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claim 6 above, and further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Aihara does not disclose the time limits or usage limits of programs on the smartcard.

Floyd discloses a content delivery system wherein product use can be either for a time period or a number of uses (see paragraph 22) and suggests that this reduces piracy by not making it fully useful to a customer until it is "purchased."

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by allowing product use for either a time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not making it fully useful to a customer until it is "purchased."

8.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,223,190 to Aihara et al. as applied to claims 1 and 6 above, and further in

view of U.S. Patent No. 5,835,396 to Zhang.

Aihara does not disclose the structure of the memory used in the flash disk.

Zhang discloses the organization of memory in a three-dimensional array (see

abstract) and suggests that this allows for increased memory density (see column 1,

lines 65-67).

Therefore, it would be obvious to one of ordinary skill in the art at the time the

invention was made to modify the invention of Aihara by using flash disks having three-

dimensional memory arrays, as disclosed by Zhang, to have increased memory density.

9.   Claims 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 6,523,117 to Oki et al. as applied to claims 20 and

23 above, and further in view of U.S. Patent No. 6,478,222 to Sarfati.

Oki does not disclose the languages and formats of applications.

Sarfati discloses a smartcard that delivers Java programs and MPEG

(audio/video) streams (see column 4, lines 14-20 and column 6, lines 26-33) and

suggests that this is advantageous because the use of these languages also allows for

the use of broadcast communications (see column 2, line 66 to column 3, line 7).

Therefore it would have obvious to one of ordinary skill in the art at the time the

invention was made to modify the invention of Oki by supporting Java and MPEG

applications on the memory stick, as disclosed by Sarfati, to allow for the use of

broadcast communications.

10.   Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 6,523,117 to Oki et al. as applied to claims 20 and 23 above, and

further in view of U.S. Patent Application Publication No. 2002/0161709 to Floyd et al.

Oki does not disclose a limitation on the time period or number of uses from the

device.

Floyd discloses a content delivery system wherein product use can be either for

a time period or a number of uses (see paragraph 22) and suggests that this reduces

piracy by not making it fully useful to a customer until it is "purchased."

Therefore, it would be obvious to one of ordinary skill in the art at the time the

invention was made to modify the invention of Oki by allowing product use for either a

time period or a number of uses, as disclosed by Floyd, as this reduces piracy by not

making it fully useful to a customer until it is "purchased."

11.   Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 6,523,117 to Oki et al. as applied to claims 20 and 23 above, and

further in view of U.S. Patent No. 5,835,396 to Zhang.

Regarding claim 34, Oki does not disclose the structure of the memory used in

the memory stick.

Zhang discloses the organization of memory in a three-dimensional array (see abstract) and suggests that this allows for increased memory density (see column 1, lines 65-67).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Oki by using memory sticks having three-dimensional memory arrays, as disclosed by Zhang, to have increased memory density.

Regarding claim 36, Oki suggests several types of media for storage, such as CD-ROM or memory stick. Since Oki discloses both the memory media and write-once media in this group, one skilled in the art would recognize that a write-once memory would also be a choice for the storage medium.

12.   Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,223,190 to Aihara et al. as applied to claims 1 and 6 above, and further in view of U.S. Patent No. 6,478,222 to Sarfati.

Aihara does not disclose the use of audio/video formats.

Sarfati discloses a smartcard that delivers MPEG (audio/video) streams (see column 4, lines 14-20 and column 6, lines 26-33) and suggests that this is advantageous because the use of these languages also allows for the use of broadcast communications (see column 2, line 66 to column 3, line 7).

Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Aihara by supporting MPEG applications

on the flash disk, as disclosed by Sarfati, to allow for the use of broadcast

communications.

13.   Claims 78 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 6,478,222 to Sarfati as applied to claims 76 and 81 above, and

further in view of U.S. Patent No. 6,766,417 to Tanaka et al.

Sarfati does not disclose the layout of the memory with respect to persistent data

storage.

Tanaka the writing of application data stored in a buffer being written to a flash

ROM that is organized by pages, which do not change during normal operation; the

area is therefore fixed (see column 5, lines 19-23 and column 6, lines 15-18) and only

available on the solid-state memory device, and notes that when a read write control

program for the information processing unit is developed for a flash ROM (write-once

memory cells) of a specific capacity, a flash ROM of some other capacity becomes

unable to be utilized by the program (see column 1, lines 40-44).

Therefore, it would be obvious to one of ordinary skill in the art at the time the

invention was made to modify the invention of Sarfati by writing application data to

pages of a flash ROM, as disclosed by Tanaka, because when a read write control

program for the information processing unit is developed for a flash ROM of a specific

capacity, a flash ROM of some other capacity becomes unable to be utilized by the

program.

14.   Claims 79 and 84 rejected under 35 U.S.C. 103(a) as being unpatentable over

U.S. Patent No. 6,6,478,222 to Sarfati as applied to claims 76 and 81 above, and further

in view of U.S. Patent No. 5,835,396 to Zhang.

Sarfati does not disclose the structure of the memory used in the smartcard.

Zhang discloses the organization of memory in a three-dimensional array (see

abstract) and suggests that this allows for increased memory density (see column 1,

lines 65-67).

Therefore, it would be obvious to one of ordinary skill in the art at the time the

invention was made to modify the invention of Sarfati by using smartcards having three-

dimensional memory arrays, as disclosed by Zhang, to have increased memory density.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

15.   Claims 1-7, 10, 11, 15, 17-19, 37-40, 43, 44, and 49-51 are rejected under the

judicially created doctrine of obviousness-type double patenting as being unpatentable

over claims 1, 2, 5, 6, 8, 10, 11, 14, and 19-22 of U.S. Patent No. 6,778,974 to Moore et

al. Although the conflicting claims are not identical, they are not patentably distinct from

each other because the '974 patent teaches to interfacing with a memory device

comprising memory cells of a semiconductor material (see '974 patent, claim 20). It is

well-known in the art to implement such memory as a solid-state device. All other

limitations are presented in the claims of the '974 patent.

Allowable Subject Matter

16.   Claims 37 and 39 would be allowable if rewritten or amended to overcome the

rejections under double patenting set forth in this Office action.

17.   Claims 16, 21, 24, 28, 29, and 33 are objected to as being dependent upon a

rejected base claim, but would be allowable if rewritten in independent form including all

of the limitations of the base claim and any intervening claims.

18.   Claims 3, 7, and 15 would be allowable if rewritten to overcome the rejections

under the doctrine of double patenting set forth in this Office action and to include all of

the limitations of the base claim and any intervening claims.

19.   The following is a statement of reasons for the indication of allowable subject

matter:

Regarding claims 3, 7, 15, 37, and 39, no art could be found that suggested the

loading of program code from a memory device that would only store additional data on

the device. Such programs commonly reside on the memory device and are never

downloaded to the host device for execution there.

Regarding claims 16, 21, 24, 28, 29, and 33, though art is cited that loads

program code for performing memory device program reading/writing and which loads

code for decryption of such code using the medium's identifier, the respective citations

are non-analogous and there would be no motivation to combine the two for this

purpose.

Claims 38 and 40-51 would be allowable based upon their dependence upon

allowable claims.

Response to Arguments

20.   Applicant's arguments filed 5 May 2006 have been fully considered but they are

not persuasive.

Regarding claims 1 and 6, in the examination of a patent application, the

meanings of claim terms are given their broadest reasonable interpretation in light of

Applicant's specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667

(Fed. Cir. 2000), *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en

banc).

In view of Applicant's specification, one skilled in the art would reasonably

interpret that, in the claimed invention, the host device requires the program code to

read the data only in the performance of the claimed method. Given that Applicant's

specification specifies a host device as being any one of a number of multi-purpose

computers (see p.3, lines 16-19) and that the disclosure does not otherwise suggest

that the host device be limited strictly to this functionality, it cannot be presumed that the

host device would be unable to otherwise function without the program code reading the

data. The claims are therefore anticipated.

Regarding claims 20 and 23, Oki's invention does rely on a remote deciphering

center for retrieving decryption keys, but the decryption itself is done on the host device

itself (see column 6, lines 48-54; also column 4, lines 59-61). The claims are therefore

anticipated.

Regarding claims 76 and 81, Sarfati discloses the storing of MPEG applications

in ROM (which is a type of solid-state memory). Since MPEG is an audio/visual data

format, the claims are anticipated.

Regarding the double patenting rejections, a dependent claim, such as claim 20

in the '974 patent, includes all the limitations of its base claim. When viewed in

combination with claim 20, the other cited claims are rendered obvious. The double-

patenting rejections are therefore proper.

Conclusion

21.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

22.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Matthew E. Heneghan, whose telephone number is

(571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30

AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jacques Louis-Jacques, can be reached at (571) 272-6962.

> **Any response to this action should be mailed to:**
>   Commissioner of Patents and Trademarks
>   P.O. Box 1450
>   Alexandria, VA 22313-1450
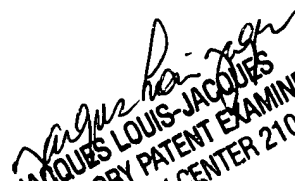> **Or faxed to:**
>   (571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH

July 10, 2006